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***In the United States Patent and Trademark Office***

Appn. Number: 09/641,410  
Appn. Filed: August 18, 2000  
Applicant: Alice Mary O'Donnell Kiely  
Title: Edible Supports for Comestibles with Optional, Edible Mess Guards and  
Drip Guards  
Examiner/GAU: Keith Hendricks/Jyoti Chawla 1794

Yorktown Heights, NY August 30, 2011

**Appeal Brief**

**To the Board of Patent Appeals and Interferences**

Assistant Commissioner for Patents

Arlington, Virginia 22313

Sir:

Applicant respectfully appeals the Examiner's and the Office of Petitions decision to make the second Office Action final. Applicant also respectfully appeals the Examiner's decisions as to the method of examination of the above application.

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**i) Real Party in Interest:**

The real party in interest for the above application is Alice Mary O'Donnell Kiely,  
Applicant pro se.

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**(ii) Related Appeals and Interferences:**

- 1) The above application 09/641,410, "Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards," filed August 18, 2000, is parent to Divisional Application Serial No. 11/903,722, Method of Supporting a Frozen Comestible, (status: Pending Appeal to the Board of Patent Appeals and Interferences.)
- 2) 10/183,074, Edible Malleable Supports for Comestibles with Optional Mess Guards and Drip Guards - filed - Appeal was Filed (co-divisional of application 11/903,722, above) An appeal was filed regarding co-divisional application 10/183,074, Edible Malleable Supports, on 12/21/2005, (now abandoned). Result: The prosecution had been reopened. The scope of coverage of the claims of this application is included in the remaining existing application(s).

The inclusion of reference to Divisional Application SR No. 11/903,722 is submitted as proper under the following: 1205.02 Appeal Brief Content [R-8] - 1200 Appeal

37 CFR 41.37(c) (1) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable, for example, a list of references, table of contents, table of cases, etc. a brief is in compliance with 37 CFR 41.37(c)(1) as long as it includes items (i) to (x) in the order set forth.

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Applicant respectfully submits that the subject matter of Application Sr. No. 11/903,722, Method of Supporting a Comestible is related to the above application under appeal and may be related to the outcome of this appeal.

### **Related Prior Proceedings**

Applicant filed petitions and Requests for Reconsideration under 37 CFR 1.181 on March 29, 2010, September 10, 2010, December 16, 2010, December 29, 2010 and May 5, 2011 requesting that the finality of the Office Action dated July 9, 2009 be withdrawn, since the finality of the Office Action was premature and improper. These petition were denied.

Examiner Hendricks conceded on 9/15/2010 in divisional application 11/903,722:

"The "composite material" was part of claim 6 of parent application 09/641.410 submitted on 8/18/2000 and thus regarded as part of original disclosure of the parent application. Therefore the amendments do not introduce any new matter and have been entered," (Exhibit J)

In a petition on 12/16/2010 (Amendments to Specification) Applicant requested the withdrawal of the finality of the second Office Action. This was based, in part, on the fact that Examiner failed to show a prima facie case of "new matter," for the term "composite material." Applicant showed Examiner that original claims 6, 19, 21 - 23, of the application recited a "composite material."

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Applicant was also required to cancel Applicant's patentable subject matter, examined in the first Office Action. Even though Examiner conceded that "composite material" was not "new matter," in the above application (Exhibit J), and this information was sent in a petition to the Office of Petitions, the petition was still unjustly denied. [emphasis added]

All rejections of Applicant's claims in 09/641,410 had been overcome with respect to Musher on 5/23/2003. Furthermore, all cited art had been overcome by Applicant in Applicant's response to the Final Office Action of application 09/641,419, Title: Edible Supports for Comestibles on 3/9/2004. Thus, Applicant's claims were patentable over all cited art and should have been allowed by the United States Patent and Trademark Office. (Exhibit K, pgs. 1 - 6)

**The relied upon reference:**

Musher is the same and sole cited art used to reject all claims of the above application. Musher constructed a: Frozen Confection and Method for Making It. (Title) Musher constructed an edible framework structure of edible flakes and ready to eat cereal pieces which holds ice cream within interstices made by the cereal flakes, which is completely frozen. (Exhibit - Patent to Musher). Musher teaches that he constructs a durable structure (pg. 1, col. 1, ll. 44) using structure pieces. (Pg. 2, col. 1, l. 22) Musher's edible structure is a structure made of many small parts.

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**(iii) Status of Claims:**

Claims 1 - 382 - canceled

Claims 383 - 416 are pending in the Office Action

Claim 383 is rejected

Claim 384 is rejected

Claim 385 is rejected

Claim 386 is rejected

Claim 387 is rejected

Claim 388 is rejected

Claim 389 is rejected

Claim 390 is rejected

Claim 391 is rejected

Claim 392 is rejected

Claim 393 is rejected

Claim 394 is rejected

Claim 395 is rejected

Claim 396 is rejected

Claim 397 is rejected

Claim 398 is rejected

Claim 399 is rejected

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Claim 400 is rejected

Claim 401 is rejected

Claim 402 is rejected

Claim 403 is withdrawn from examination by Examiner without any evidence of being a non-elected invention

Claim 404 is withdrawn from examination by Examiner without any evidence of being a non-elected invention

Claim 405 is withdrawn from examination by Examiner without any evidence of being a non-elected invention

Claim 406 is withdrawn from examination by Examiner without any evidence of being a non-elected invention

Claim 407 is withdrawn from examination by Examiner without any evidence of being a non-elected invention

Claim 408 is withdrawn from examination by Examiner without any evidence of being a non-elected invention

Claim 409 is withdrawn from examination by Examiner without any evidence of being a non-elected invention

Claim 410 is withdrawn from examination by Examiner without any evidence of being a non-elected invention

Claim 411 is withdrawn from examination by Examiner without any evidence of being a non-elected invention

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Claim 412 is withdrawn from examination by Examiner without any evidence of being a non-elected invention

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Claim 414 is withdrawn from examination by Examiner without any evidence of being a non-elected invention

Claim 415 is withdrawn from examination by Examiner without any evidence of being a non-elected invention

Claim 416 is withdrawn from examination by Examiner without any evidence of being a non-elected invention



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**(iv) Status of Amendments:**

10/9/2009      proposed amendment by Applicant  
10/26/2009      Advisory Action states the amendment is not entered  
11/22/2009      proposed amendment by Applicant  
1/28/2010      advisory action states the amendment is not entered

The Final Office Action states that the Office Action is in response to communication filed on March 16, 2009.

Applicant has attached claims 383 - 416 of Applicant's response to the Non-Final Office Action of March 16, 2009 which were said to be pending and examined by the Office prior to the Final Office Action of September 15, 2010.

Claims 383 - 416 do not contain any non-entered amendments.

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**(v) Summary of Claimed Subject Matter:**

Example(s) from the specification is/are provided.

N.B. Applicant has used the published specification of Application SR 11/903,722 for these paragraph examples, since the specification of Application SR No. 09/641,410 is not published.

**Claim 383 -** A non-frozen support for a frozen comestible comprises an edible confectionary material comprising two ingredient materials within said edible confectionary material or two constituent materials. The edible material comprises two materials.

An example(s) being: [0164] lines 2-6 (Milky Way Bar (tm), one ingredient material being whipped chocolate nougat and the other ingredient material being caramel ); [0164] line 5 - 7 (Twix Cookie/Candy Bar (tm), i.e. ingredient material being caramel and the other ingredient material being a cookie), Figure 15A; Figure 13A item 100, Also [0165] Butterfinger (tm), Snickers (tm), 100 Grand, Baby Ruth [0166] lines 1-3 Kudos Granola Bar (tm);

**Claim 384 -** The two materials of claim 383 each can comprise a candy, a whipped confection, a colored candy chip, a flavored candy chip, a nut, a candy bead, a fluid material, fudge, peanut butter, cheese, coconut, nougat, dried yogurt creme, gelatin, a cookie, a cracker, a wafer, a bread stick, a potato stick, a pretzel, a whole grain ,

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chewing gum, or fruit. An example(s) being: [ 0164] lines 2-3; [0165] lines 2-5; [0167] line 2.

Claim 385 - The two materials of claim 383 are characterized as the edible material. An example(s) being: [Fig. 13A - item 100];

Claim 386 - The edible material of claim 383 comprises a bite size ingredient placed inside or embedded in the support. An example(s) being: [0338] lines 9 - 10, [Fig. 13A - item 100].

Claim 387 - The edible material of claim 383 comprises a support. [0044] 62A Edible cylindrical composite [material] support. [0228] (Fig. 16B) "Support 62A can be a combination of two or more sticks, from top to bottom, that can be twisted or attached together for a variety of flavors and appearances, such as the candy sold under the trademark the Wizard of Oz Kansas Twisters by Hollywood Partners, Inc. of Los Angeles, Calif." ([0044] 62A edible cylindrical composite [material] support.) [0164] line 5 - 7 (Twix Cookie/Candy Bar (tm), [0164] last line, "A frozen Twix candy bar efficiently supports confection 84." An example(s) being: [0323] See last sentence.

Claim 388 - The edible material of claim 383 comprises a handle. [0228] (Fig. 16B) "Support

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62A can be a combination of two or more sticks, from top to bottom, that can be twisted or attached together for a variety of flavors and appearances, such as the candy sold under the trademark the Wizard of Oz Kansas Twisters by Hollywood Partners, Inc. of Los Angeles, Calif.” (As above) An example(s) being: [0238] “Supports 62A are used as handles in FIGS. 16A-C and Figs. 17-19. (Includes Fig. 16B, “two or more sticks ...attached together...” directly above). [0044] 62A edible cylindrical composite [material] support.

Claim 389 - The support for a frozen comestible of claim 383 wherein the support comprises a single component. The support is not different parts put together but comprises a material comprising two ingredient materials. An example(s) being: [0163] [0043] [0164] Lines 1-6, [0165] Snickers (tm), 100 Grand (tm), Baby Ruth (tm), Mounds (tm), Almond Joy (tm) i.e. single bar (component) [0166] Kudos (tm). See lines 1-6.

Claim 390 - The support for a frozen comestible of claim 383 wherein the edible material comprises an edible composite material. The composite material comprises two ingredient or constituent materials. An example(s) being: [original disclosed claims 6, 19-23], [0186] “a list of some suitable supports, are as follows:” [0187] “*composite candy bar* with caramel, whipped chocolate nougat which is dipped in chocolate,” [0164] “*elongated dense cookie*” i.e. Twix (tm)] [0188] “*composite*

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*candy bar* with an elongated cookie stick, with caramel on top of the caramel, [cookie], which is then dipped in chocolate,” [0190] “*composite candy bar* with chocolate, nuts and nougat inside,” [0164] Lines 1-6, Milky Way (tm), and cookie bar, Twix (tm); [0165] See lines 1-6. [0166] lines 1-3. granola bar, Kudos (tm).

Claim 391 - The support for a frozen comestible of claim 383 wherein one of the two constituent materials comprises an edible hollow confection length, and the other of the two constituent materials comprises an edible filling placed in the hollow length. An example(s) being: [0206] lines 1-3, and lines 4-5.

Claim 392 - The support for a frozen comestible of claim 383 further comprises an ingredient in the edible material. An example(s) being: a candy [0164].. nuts [0124], ... a fluid ingredient [0206], chewing gum [0169] , shortening, oil [0160], a cookie [0164] , a cracker [0187], a wafer a bread stick a potato stick, a pretzel, fudge, peanut butter, whole grain... cereal [0187], fruit, a binder... or a combination thereof. Examples include: [0164] Lines 1-6, [0165] See lines 1-6, [0166] lines 1-3, gum, 90187) lines 7-8 whole grain,... an edible composite material [0338] (ingredient 100 Fig. 13A), a soft gummy appendage, [0339] tongue, or combinations thereof [0339] line 3.

Claim 393 - The support for a frozen comestible of claim 383 further comprises a supported

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frozen comestible. An example(s) being: (Fig. 1, item 84), a plurality of supported frozen comestibles (Fig. 3), a frozen supported comestible [0264] a lollipop [Fig. 2, item 100], a mess guard [Figs. 1, 2, item 76], a drip guard [Figs. 15C-D, item 80], wood, plastic or paper [0339], ...loops [0207],... packaging [Figs. 23, 24], ...gripping indentations [Fig. 6, item 68][0180], frozen comestible supported in the core of the support [0339], support for sharing [0334], freestanding portion [Figs. 25A-C], plurality of handles [Figs. 10, 11], a wearable support [Fig. 26B], a composite material, a material that comprises two materials [0338][Fig. 13A, item 100 attached or embedded], confection bar [0334], a void [Figs. 5, 15B-D, item 66].

**Claim 394 -** A support for a frozen comestible comprising an edible composite material. The edible composite material comprises two ingredient or constituent materials. An example(s) being: [original disclosed claims 6, 19-23], [0186] “a list of some suitable supports, are as follows:” [0187] “*composite candy bar* with caramel, whipped chocolate nougat which is dipped in chocolate,” [0164] “*elongated dense cookie*” i.e. Twix (tm)) [0188] “*composite candy bar* with an elongated cookie stick, with caramel on top of the caramel, [cookie], which is then dipped in chocolate,” [0190] “*composite candy bar* with chocolate, nuts and nougat inside,” (Snickers), [0164] Lines 1-6, Milky Way (tm), and cookie bar, Twix (tm); [0165] See lines 1-6. [0166] lines 1-3. granola bar. Kudos (tm).

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- Claim 395 - The support for a frozen comestible of claim 394 wherein each of the two ingredient or constituent materials comprise a candy, a whipped confection... a nut a candy bead, a fluid ingredient... peanut butter, cheese, ... a cookie, a cracker, a wafer, a bread stick, a potato stick, a pretzel, a whole grain, chewing gum, or fruit. An example(s) being: [ 0164] lines 2-3; [0165] lines 2-5; [0167] line 2.
- Claim 396 - The support for a frozen comestible of claim 394, wherein the two ingredient or constituent materials are characterized as the edible composite material. An example(s) being: [Fig. 13A - item 100];
- Claim 397 - The support for a frozen comestible of claim 394, wherein the edible composite material comprises a bite size ingredient placed inside or embedded in the support. An example(s) being: [0338] lines 9 - 10.
- Claim 398 - The support for a frozen comestible of claim 394, wherein the support comprises a handle. An example(s) being: [0159] line 3. [0172] lines 5-6.
- Claim 399 - The support for a frozen comestible of claim 394 wherein the support comprises a non-frozen support. An example(s) being: [0186] "a list of some suitable supports, are as follows:" [0187] "*composite candy bar* with caramel, whipped chocolate nougat which is dipped in chocolate," [0164] "*elongated dense cookie*"

i.e. Twix (tm)) [0188] "*composite candy bar* with an elongated cookie stick, with caramel on top of the caramel, [cookie], which is then dipped in chocolate," [0190] "*composite candy bar* with chocolate, nuts and nougat inside," (Snickers), [0164] Lines 1-6, Milky Way (tm), and cookie bar, Twix (tm); [0165] See lines 1-6. [0166] lines 1-3. granola bar, Kudos (tm).

Claim 400 - The support for a frozen comestible of claim 394 wherein the support comprises a single component. An example(s) being: [0186] "a list of some suitable supports, are as follows:" [0187] "*composite candy bar* with caramel, whipped chocolate nougat which is dipped in chocolate," [0164] "*elongated dense cookie*" (i.e. Twix (tm))) [0188] "*composite candy bar* with an elongated cookie stick, with caramel on top of the caramel, [cookie], which is then dipped in chocolate," [0190] "*composite candy bar* with chocolate, nuts and nougat inside," (i.e. Snickers (tm)),

Claim - 401 The support for a frozen comestible of claim 396, further comprises an ingredient in the edible material. An example(s) being: a candy [0164].. nuts [0124], ... a fluid ingredient [0206], chewing gum [0169] , shortening, oil [0160], a cookie [0164] , a cracker [0187], a wafer a bread stick a potato stick, a pretzel, fudge, peanut butter, whole grain... cereal [0187], fruit, a binder... or a combination thereof. Examples include: [0164] Lines 1-6, [0165] See lines 1-6,



[0166] lines 1-3, gum, 90187) lines 7-8 whole grain,... an edible composite material [0338] (ingredient 100 Fig. 13A), a soft gummy appendage, [0339] tongue, or combinations thereof [0339] line 3.

Claim - 402 The support for a frozen comestible of claim 396, further comprises a supported frozen comestible, An example(s) being: (Fig. 1, item 84), a plurality of supported frozen comestibles (Fig. 3), a frozen supported comestible [0264] a lollipop [Fig. 2, item 100], a mess guard [Figs. 1, 2, item 76], a drip guard [Figs. 15C-D, item 80], wood, plastic or paper [0339], ...loops [0207],... packaging [Figs. 23, 24], ...gripping indentations [Fig. 6, item 68][0180], frozen comestible supported in the core of the support [0339], support for sharing [0334], freestanding portion [Figs. 25A-C], plurality of handles [Figs. 10, 11], a wearable support [Fig. 26B], a composite material, a material that comprises two materials [0338][Fig. 13A, item 100 attached or embedded], confection bar [0334], a void [Figs. 5, 15B-D, item 66].

Claim - 403 The support for a frozen comestible of claim 396, further comprises a supported frozen comestible, An example(s) being: (Fig. 1, item 84), a plurality of supported frozen comestibles (Fig. 3), a frozen supported comestible [0264] a lollipop [Fig. 2, item 100], a mess guard [Figs. 1, 2, item 76], a drip guard [Figs. 15C-D, item 80], wood, plastic or paper [0339], ...loops [0207],... packaging [Figs. 23, 24],

...gripping indentations [Fig. 6, item 68][0180], frozen comestible supported in the core of the support [0339], support for sharing [0334], freestanding portion [Figs. 25A-C], plurality of handles [Figs. 10, 11], a wearable support [Fig. 26B], a composite material, a material that comprises two materials [0338][Fig. 13A, item 100 attached or embedded], confection bar [0334], a void [Figs. 5, 15B-D, item 66].

**Claim - 403 -** A non-frozen support for a frozen comestible comprising an edible material that comprises two ingredient materials within the edible material or two constituent materials and means for making the support. All figures 1 - 43, and paragraphs [0001] - [0342] have an impact on how the support for a frozen comestible is made, either directly, or by way of various combinations of different embodiments. See: [0157]. 35 USC section 112, paragraph 6.

**Claim 404 -** The support for a frozen comestible of claim 403 further comprises a frozen comestible and means for making a frozen supported comestible. All figures 1 - 43, and paragraphs [0001] - [0342] have an impact on how the support for a frozen comestible is made, either directly, or by way of various combinations of different embodiments. See: [0157]. 35 USC section 112, paragraph 6.

**Claim 405 -** A method of making a support for a frozen comestible comprises comprising an

edible material comprising two ingredient or constituent materials within said edible material. The two ingredient or constituent materials are characterized as the edible material. An example being: [Fig. 13A - item 100];

Claim 406 - A method of making a support for a frozen comestible of claim 405 wherein each of the two ingredient materials comprises a candy, a whipped confection, a colored candy chip, a flavored candy chip, a nut, a candy bead, a fluid material, fudge, peanut butter, cheese, coconut, nougat, dried yogurt creme, gelatin, a cookie, a cracker, a wafer, a bread stick, a potato stick, a pretzel, a whole grain, chewing gum, or fruit. An example(s) being: [ 0164] lines 2-3; [0165] lines 2-5; [0167] line 2.

Claim 407 - A method of making a support for a frozen comestible of claim 405 further comprising an ingredient in the edible material. An example(s) being: a candy [0164].. nuts [0124], ... a fluid ingredient [0206], chewing gum [0169] , shortening, oil [0160], a cookie [0164] , a cracker [0187], a wafer a bread stick a potato stick, a pretzel, fudge, peanut butter, whole grain... cereal [0187].

Claim 408 - A method of making a support for a frozen comestible of claim 405 wherein the edible material comprises a non-frozen material, a support, a non frozen support, a handle, a confectionary material, a composite material, a composite material

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confection bar, ... two twisted ingredient materials, two mixed ingredient materials, two attached ingredient material, two molded ingredient materials, two layered materials, two swirled ingredient materials, two concentrically placed ingredient materials, ... or combinations thereof. An example(s) being: [0173], [0184],[0228], [0308]

**Claim 409 -** A method of making a support for a frozen comestible of claim 405, further comprises supporting a frozen comestible. An example being: (Fig. 1, item 84).

**Claim 410 -** A method of making a support for a frozen comestible of claim 405, further comprises freezing the support. An example being: [0183] line 1.

**Claim 411 -** A method of making a support for a frozen comestible of claim 405, further comprises freezing the support and the supported frozen comestible. An example being: [0183] lines 2-3.

**Claim 412 -** A method of making a support for a frozen comestible comprises comprising an edible composite material. The edible composite material comprises two ingredient materials. The two ingredient materials are characterized as the edible composite material, whereby a support may provide synergistic strength to sustain stress against breakage, while also providing a long lasting support with a variety

of edible taste and texture combinations. An example being: [Fig. 13A - item 100]

Claim 413 - A method of making a support for a frozen comestible of claim 412 wherein the edible material comprises a non-frozen material, a support, a non frozen support, a handle, a confectionary material, a composite material, a composite material confection bar, ... two twisted ingredient materials, two mixed ingredient materials, two attached ingredient material, two molded ingredient materials, two layered materials, two swirled ingredient materials, two concentrically placed ingredient materials, ... or combinations thereof. An example(s) being: [0173], [0184],[0228], [0308]

Claim 414 - A method of making a support for a frozen comestible of claim 412 further comprises an ingredient in the edible material that comprises two materials. An example being: a candy [0164].. nuts [0124], ... a fluid ingredient [0206], chewing gum [0169] , shortening, oil [0160], a cookie [0164] , a cracker [0187], a wafer a bread stick a potato stick, a pretzel, fudge, peanut butter, whole grain... cereal [0187], fruit, a binder... or a combination thereof.

Claim 415 - A method of making a support for a frozen comestible of claim 412, further comprises supporting a frozen comestible. An example being: (Fig. 1, item 84).

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Claim 415 - A method of making a support for a frozen comestible of claim 412 further comprises freezing the support and the supported frozen comestible. An example being: [0183] lines 2-3.

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**(vi) - Grounds of Rejection to be Reviewed Under Appeal**

Applicant respectfully submits that the examination of the above application is improper, unlawful, and prejudicial in nature. The Office is aware of the merits of the claims of the above application, yet continues to examine the application in an unlawful manner in disregard to rules and laws, not to mention the disregard to Applicant, Applicant's due diligence, and Applicant's occupation. The Office acted upon the merits of the claims in a first Office Action on 5/23/2003, which were determined to be: "'a composite' - comprising elements a through m." (MPEP 818.02(a)) The Office Action since has unjustly required Applicant to cancel Applicant's patentable subject matter as a condition of the examination, i.e. "cancel...in response to this Office Action." (Pages 3 - 4 of Non-final Office Action) (Pages 3 - 4 of the Final Office Action.) This condition extends to the Specification under 35 132(a); to 35 USC Section 112, First Paragraph, and to 35 USC Section 112, Second Paragraph, and thus 35 USC Section 102.

In addition, all method and means claims have been unjustly removed from examination without valid evidence, reason, or explanation of how claims 370 - 382 / 403 - 416 are directed to a distinct, non-elected invention. Method claims were present upon filing on August 18, 2000 and acted upon in the first Office Action. (Exhibit L, pgs. 1 - 2)

Furthermore, the reference to Lane et al. (US 1,690,984), introduced in the final Office Action was improper, as this reference could have been cited in the Non-final Office Action. The noted

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claim was of the record, in its entirety, prior to the Non-final Office Action.

Applicant respectfully submits that the finality of the second Office Action was premature.

Applicant respectfully requests favorable reconsideration and withdrawal of the finality of the Office Action.

A failure to provide the best case such that a new rejection, new art, and/or expanded arguments are required in a subsequent Office Action generally precludes the finality of that subsequent Office Action. (See MPEP §706.07(a)). In practice, this prevents piecemeal prosecution of the application, which the MPEP instructs should be avoided. (MPEP §707.07(g)).

**1) Finality of Office Action**

The Second Office Action of 7/9/2009 stated:

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, THIS Office Action IS MADE FINAL. See MPEP section 706.07(a).

**Issue:**

Whether Examiner erred in making the Office Action of July 9, 2009 final, under 706.07(a) Final Rejection when Proper on Second Action, in view of MPEP



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707.07(g) Compact Prosecution (The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See MPEP § 904.03.).

MPEP 818.02(a) (The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application.); and,

MPEP 2111 "Broadest Reasonable Interpretation consistent with the Specification" (does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent. See *Schriber-Schroth Co. v. Cleveland Trust Co.*,...)

## 2) Election/Restriction

The [First and] Second Office Action stated:

Newly submitted claims 403-416 are directed to a method of making a support i.e. an invention that is independent or distinct from the invention elected in response filed January 18, 2003 to the original restriction requirement since Applicant had elected a product and not the method of making in response to the election requirement the method of making the product i.e. , claims 403-416 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP section 821.03. Thus claims 403 will not be examined in

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the present Office Action.

**Issues:**

Whether Examiner erred in making the second Office Action final under 37 CFR 1.142(b), MPEP Section 821.03, in view of MPEP Section 821.03(paragraph 8.04) "for the following reasons;" 707.07(g) Compact Prosecution; and MPEP 803 - Restriction when Proper (only if they are able to support separate patents and they are either independent (MPEP § 802.01, § 806.06, and § 808.01<) or distinct ( MPEP § 806.05 - § 806.05(j)<).

**3) Amendments to Specification**

The Second Office Action stated:

The amendment filed March 16, 2009 is once again objected to under 35 USC 132(a) because it introduces new matter into the disclosure. 35 USC 132(a) states that no amendment shall introduces new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the addition of "composite material" in paragraphs [0043][0044][0164] and [0166], which was not disclosed in the specification as originally filed and has also been added to claims. The term "composite material" as disclosed in the amendment would introduce new matter and change the description from " a candy bar" to "a composite candy bar in" paragraph [0164]

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which is not the same as a generic term "candy bar" as originally described.

Therefore the amendments to the specification introduce new matter and the applicant is required to cancel the new matter in the reply to this Office Action.

**Issue:**

Whether the term "composite material" constitutes "new matter" in the specification under 35 USC 132(a), in view of MPEP 818.02(a) (The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application.), MPEP 2111 "consistent with the specification," and MPEP 608.01 - Original Claims: in establishing a disclosure, applicant can rely not only on the description and drawing as filed but also on the original claims if their content justifies it.

Whether Examiner erred in making the second Office Action final under MPEP 707.07(f) Answer all Material Traversed

**4. 35 USC Section 112 (First paragraph)**

The Final Office Action stated:

Claims (all pending) are rejected under 35 USC 112 first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled

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in the art to which it pertains or with which it is most nearly connected to make an/or use the invention. In the instant case the term "composite material" as added to the claims introduce new matter as the term is not disclosed in the original disclosure and the introduction of the term "composite material" changes the description of "a candy bar" to "a composite material candy bar," which is not the same as a generic term candy bar as originally described. ... therefore, the amendments to the claims introduce new matter and the applicant is required to cancel the new matter in the reply to this Office Action.

**Issue:**

Whether the term "composite material" constitutes "new matter" and is not enabled in claims 383 - 402 under 35 USC 112 (first paragraph).

Whether Examiner erred in making the second Office Action final under 35 USC 112 (first paragraph), in view of MPEP 818.02(a) (The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application.); MPEP 608.01 - Original Claims: in establishing a disclosure, applicant can rely not only on the description and drawing as filed but also on the original claims if their content justifies it; and MPEP 2182 Scope of the Search and Identification of the Prior Art [R-2] [A patent specification need not teach, and preferably omits, what is well known in the art. ...]

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**5. 35 USC Section 112 (Second paragraph)**

The final Office Action stated:

Claims (383 - 402) are indefinite for the recitation of "composite material."

Applicant has not distinguished between the terms in the specification and thus the claim as recited is unclear as to what is the scope of the term composite material. It is unclear whether the claim requires materials that can form a composite or materials that are composites themselves or some other.

Further a composite is defined as "made of separate element", i.e. made of more than one element, i.e. comprising a minimum of two ingredient materials. Thus, applicant has chosen to redefine a known term.

**Issue:**

Whether the term "composite material" is unclear or indefinite in claims 383 - 402 under 35 USC Section 112 (second paragraph)

Whether Examiner erred in making the second Office Action final under 35 USC Section 112 (second paragraph), in view of MPEP 707.07(f) Answer All Materials Traversed; MPEP 818.02(a) (The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application.), MPEP 2182 Scope of the Search and Identification of the Prior Art [R-2] [A patent specification need not teach, and preferably omits, what is well

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known in the art. ...]; and MPEP 608.01 Original Claims

6) **35 USC Section 102**

**The Office Action States:**

Musher teaches ice cream (frozen comestible) on an edible support structure or a composite support which has at least two edible discernable (i.e. perceptible) edible materials or components or members that are combined together to make the support..."

**Issue:**

Whether Examiner erred in making the Second Office Action final under MPEP 818.02(a) (The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application.); MPEP 707.07(g) Piecemeal Examination; MPEP 2111 "Broadest reasonable interpretation consistent with the specification."

7) **35 USC Section 103**

**The Final Office Action states:**

The final Office Action stated:

(A) claim 391 is rejected under 35 USC 103(a) as being unpatentable over Feybusch in view of Lane et al. (US 1690984)

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**Issue:**

Whether Examiner erred in making the second Office Action final under 706.07(a)  
Final Rejection, When Proper on Second Action and in view of 707.07(g)  
Piecemeal Examination - Compact Prosecution.

Whether Examiner erred in making the second Office Action final in introducing a  
new reference to Feybusch eight (8) years after the application was submitted on  
8/18/2000 under 707.07(g). Piecemeal Examination - Compact Prosecution

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**(vii) Argument****1) Finality of Office Action**

Applicant respectfully submits that the finality of the Office Action of July 9, 2009 was premature. Applicant disagrees that Applicant's amendment necessitated the new ground(s) of rejection presented in the final Office Action under MPEP 706.07(a).

In addition, Applicant respectfully submits that the Office Actions were improper. The Office Actions and rejections are unfairly based upon a continual, erroneous misinterpretation of the known merits of the claims. The claim rejections and objections are based upon "composite support." Applicant's invention comprises "a support for a frozen comestible comprising a material that comprises two materials," and, "a support for a frozen comestible comprising an edible composite material."

NOTE: In the presence of patentable subject matter, the Office has denied assistance under 707.07(j) for over eight years.

**The Second Office Action Should Not Have Been Made Final  
as NEITHER the First Office Action, NOR the Second Office Action Had  
CONSIDERED THE MERITS OF ANY CLAIM**



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**Of Special Interest:**

Information on 11/903,722 - Method of Supporting a Comestible - divisional, same Examiner(s) - 9/15/2010), is submitted to be proper under 1205.02 Appeal Brief Content [R-8] - 1200 Appeal 37 CFR 41.37(c) (1), as above.

In an Office Action of 9/15/2010, for divisional application 11/903,722, titled: Method of Supporting a Comestible, the Office has acknowledged:

The "composite material" was part of original claim 6 of parent application 09/641,410 submitted on August 18, 2000, and thus regarded as part of original disclosure of the parent application. Therefore, the amendments do not introduce any new matter and have been entered." (Exhibit J)

Claim 6 recited:

"The edible support of claim 1 wherein said support is a composite material..."

The final Office Action of 7/9/09 (page 14 - Conclusion) stated:

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly THIS ACTION IS MADE FINAL. See MPEP section 706.07(a).

**The Notice of Abandonment stated:**

The application is abandoned in view of:

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Applicant's failure to timely reply a "proper reply" to the office letter mailed 09/July 2009.

A proposed reply was received on 11/12/09, but it does not constitute a proper reply under 37 CFR 1.113(a) to the final rejection.

37 CFR 1.113(a): (b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

In response, Examiner did not state any valid grounds of rejection applicable to the claims in the application or any valid reasons in support thereof. Applicant in fact had sent a proper and timely reply directed to placing the claims in better condition for allowance, as acted upon by the Patent and Trademark Office in the first Office Action on 5/23/2003. This was a proper and timely response. Examiner wanted Applicant to "cancel" Applicant's patentable subject matter as a "proper reply" to the Office Action. (Pg. p. 3; pg. 4, p.1 of final Office Action)(Page 3, p. 1; 4, p. 2 of non-final Office Action) Since Applicant did not cancel Applicant's subject matter, the petitions were denied. Applicant has given support for Applicant's patentable subject matter for eleven years. Applicant was refused assistance under 707.07(j).

The relevant portion of 706.07(a) Final Rejection states:

**706.07(a) Final Rejection, *When Proper* on Second Action [R-6]**

Under present practice, second or any subsequent actions ON THE MERITS shall

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be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

The above portion of MPEP 706.07(a) first states:

“second or any subsequent actions on the MERITS shall be final...”

The Office Action of 10/16/08 stated:

Claims 349-369 are rejected under 35 USC 102(b) as being anticipated by Musher. (US 2217700)

Musher teaches ice cream (frozen comestible) on an edible **support** structure or a composite support **which has** at least **two** edible discernable (i.e. perceptible) edible **materials** or components or members that are combined together to make the support, i.e, two combined ingredient materials (Page 1: Column 1 lines 37-46 and Column 2 lines 40 - 45) also (page 4: column 1 line 72 to Column 2, line 23), as instantly claimed.

Independent claim 349 recited:

**349.** A support for a frozen comestible comprising an edible material comprising two edible ingredient materials.

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Independent claim 360 recited:

**360.** A support for a frozen comestible comprising an edible composite material.

### **The Patent and Trademark Office Acted Upon the Merits of the Claims in 2003**

The Patent and Trademark Office's first Office Action on the merits of claims 79 -98 were directed to "**a composite**" comprising **elements a through m**," on May 23, 2003.

MPEP 818.02(a) The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application,..."

MPEP 2111 Broadest reasonable interpretation consistent with the specification"

The first Office Action May 23, 2003, section 112, first paragraph, stated:

"In fact, since the edible support is disclosed as being a composite, how can it be homogenous? The two are mutually inconsistent." (Underline drawn by Examiner)  
(Exhibit A, page 4)

In regard to claim 76, claim 76 can be construed to recite that the edible support comprises one or more elements a through m, and particulate matter and a homogenous comestible.

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Elements of claim 76: a) a sugar, b) a sugar substitute, c) a candy ingredient, d) candy, e) a candy bar, f) a candy bar ingredient, g) a confection, h) a confection substitute, i) fruit, j) nuts, k) grain, l) a medicinal ingredient, m) chewing gum...edible particulate matter, a homogenous comestible (page 2 of OA - May 23, 2003, section 112, first paragraph)

Thus, the Office is well aware of the merits of Applicant's claims. [emphasis added]

A person having ordinary skill in the art is knowledgeable that an examination of "composite support" does not touch the merits of, or consider, "a composite." Thus, none [emphasis added] of claims 349 - 382 had been examined. (MPEP 707.07(g)) A person having ordinary skill in the art also is knowledgeable that the term and understanding of "composite material" is well known and Applicant is not required to state how to make and/or use a composite material, and no undue experimentation is required to make and/or use an edible composite material. MPEP 2182: A broad interpretation of "composite material" results in either "a composite" or "a composite material." A broad interpretation does NOT turn "a composite" into a mere "composite support." [emphasis added] MPEP 2111; (also see APPENDIX B - IDS Tuwien - composite refers to a material, as opposed to a structure or a component "thus it should be distinguished from a wing or other structure made of several components bonded together," and below.)

The Patent and Trademark Office has determined that the term "composite material" is so well known that patents are issued without an application even mentioning or teaching about "composite materials" in the specification.

Patent Serial No. 6,004,606, (December 21, 1999) and Patent Serial No. 6,284,294 (September 4, 2001) were awarded to French, et al., in which the term "composite material" was never even mentioned in the specification, only in the claims. (See claims 1, and 12, 13, respectively)

35 U.S.C. 282 Presumption of validity; defenses. "A patent shall be presumed valid."

Both Office Actions should have examined Applicant's claims as either "a composite," or "a composite material," not a "composite support." Neither did.

Accordingly, the finality of the Office Action was indeed premature. MPEP (707.07(g))

Applicant's IDS, September 10, 2007, second entry:

[http://mmc-assess.tuwien.ac.at/2index, htm](http://mmc-assess.tuwien.ac.at/2index.htm) (APPENDIX B):

1) General Definition:

**Composite:** a composite (or composite material) is defined as a material that consists of at least two constituents (distinct phases or combinations of phases which are bonded together along the interface in the composite, each of which originates from a separate ingredient material which pre-exists the composite.

The essential elements of this definition are:

composite refers to a material,

as opposed to a structure or a component;

as such a composite material is used for the fabrication of components of various

shapes or functions, thus it should be distinguished from a wing or other structure made of several components bonded together..."

The Office determined the merits of the claims were directed to a support comprising "a composite" i.e. "a composite material comprising elements a through m,"... a candy, fruit, nut, a grain, chewing gum, edible particulate matter, a homogenous comestible. (MPEP 818.02(a))

Examiner is not an automaton and understood from the specification, claims, and drawings that "composite support 62," (Species III, wherein the support is a composite support as shown e.g. in Fig. 1, comprises a material such as a **Milky Way Bar (tm)**, a **Twix Cookie Bar [0164]**; a **Butterfinger Bar (tm)**, **Snickers Candy Bar (tm)**, **100 Grand Candy Bar (tm)**, **Baby Ruth Candy Bar (tm)**, **Almond Joy Candy Bar (tm)**, **Kudos Granola Bar (tm)**, **Nestle Bites (tm)**; [0165], i.e. edible "composite material candy bars" [emphasis added] (Exhibit A, pages 6 - 8) Drawings (Exhibit A, pgs. 9, 10)

The merits of the claims are well established by the Patent and Trademark Office. The Office Action of 10/16/08 failed to address the merits of claims 349 - 382 on *any* valid grounds. (MPEP 707.07(g)). The Final Office Action of 7/9/09 also failed to address the merits of claims 383 - 416. (MPEP 707.07(g)). Accordingly, for this reason, the finality of the second Office Action was clearly premature.

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### Claim Interpretation | Broadest Reasonable Construction

Regarding unreasonably broad claim interpretations furthered by the USPTO, the Federal Circuit has stated:

"Although the PTO emphasizes that it was required to give all 'claims their broadest reasonable construction' particularly with respect to claim 4's use of the open-ended term 'comprising,' see *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed.Cir.1997) ('the open-ended term comprising . . . means that the named elements are essential, but other elements may be added'), this court has instructed that any such construction be 'consistent with the specification, . . . and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.' *In re Bond*, 910 F.2d 831, 833 (Fed.Cir.1990) (quoting *In re Sneed*, 710 F.2d 1544, 1548 (Fed.Cir.1983)).

The PTO's construction here, though certainly broad, is unreasonably broad. The broadest-construction rubric coupled with the term 'comprising' **does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent.** See *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217, 61 S.Ct. 235, 85 L.Ed. 132 (1940) ('The claims of a patent are always to be read or interpreted in light of its specification.'). (In *re Suitco Surface, Inc.*, 603 F.3d 1255 (Fed. Cir. 2010) . . .

N.B.

In view of the above, it is **improper if an Examiner employs "an unreasonable claim construction and a strained reference interpretation that is inconsistent with the reach of the claimed subject matter when given its broadest reasonable interpretation consistent with the subject Specification as it would have been understood by one of ordinary skill in the art."** (see *Ex parte Ma et al.*, Appeal No. 2010-3794 (BPAI 2010)).

### The Office Action Failed to Mention Any Claim by Number In the Detailed Action

The Office Action of 1/16/09 stated: claims 349 - 369 are rejected under 35 USC 102(b) as being anticipated by Musher (US 221 7700).



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N. B. The Office Action however failed to mention any claim by number in the detailed action with regard to the reference to Musher. Rejections of limitation(s) are garbled and unidentifiable. Applicant is left to speculate as to the basis for the rejection of each claim. "Each claim" had not been properly rejected. (MPEP 707.07(g) The Office Action is deficient for this additional reason. Consequently, the finality of the Office Action was premature.

The INITIAL burden of establishing unpatentability resides with the Patent and Trademark Office. It is the obligation of the Office to "reject each claim on all valid grounds." (MPEP 707.07(g) - Piecemeal Examination)

If the Office has not fulfilled its obligation, the burden does NOT shift to the applicant for any reason, and thus any action made by an applicant "after the fact," cannot necessitate new grounds of rejection. Not one of Applicant's claims 349 - 382, 383 - 416 had been rejected on "valid grounds." (MPEP 707.07(g)). (Exhibit J - 11/903722 rejection on "composite material" ) Not one of Applicant's claims 349 - 382, 383 - 416 has been properly rejected.

Since the Office did not reject each claim on valid grounds in the Office Action, nor present a prima facie case of unpatentability of the known merits, the burden to prove unpatentability remains with the Office. Thus, an amendment by Applicant DID NOT necessitate the new grounds of rejection presented in the Office Action.

[The Federal Circuit has stated: "the examiner bears the initial burden, on review of the prior art or on any other ground of presenting a prima facie case of unpatentability." In re Wtiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Accordingly the Patent Office has the initial duty of supplying the factual basis for its rejection. It may not resort to speculation, **unfounded assumptions** or hindsight reconstruction to supply deficiencies in its factual basis. In re Warner, 379 F.2d 1011, 1017 (CCPA 1967)

In view of the foregoing, if an Office Action fails to provide the requisite factual basis for an anticipation rejection, it is submitted that the rejection is deficient as the Applicant is left to speculate as to the basis for the rejection. The BPAI considers such a deficiency reversible error: (as below)

### **Policy of Compact Prosecution**

The Manual of Patent Examination Procedure section 707.07(g) Piecemeal Examination states: Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See MPEP § 904.03.) ...In cases where there exists a sound rejection on the basis of prior art which discloses the "heart" of the invention (as distinguished from prior art which merely meets the terms of the claims), secondary rejections on minor technical grounds should ordinarily not be made.

[T]he precise language of 35 U.S.C. § 102 that '(a) person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103. In re Warner, 379 F.2d 1011, 1016 (CCPA 1967).

### **The Office's Obligations**

A first Office Action on the merits should ordinarily identify every issue that stands between the applicant and allowance of the application. (Manual of Patent Examining Procedure §707.07(g)). And, the Office Action should do so by presenting the best case against patentability. (See, for example, MPEP §§2164.04 and 2106II). In theory, this provides an applicant with the opportunity to respond to each issue so that, if each issue is successfully rebutted or otherwise addressed, the application would be condition for allowance. Conversely, if the applicant not successful, the application should be in condition for appeal. *A failure to provide the best case such that a new rejection, new art, and/or expanded arguments are required in a subsequent Office Action generally precludes the finality of that subsequent Office Action. (See MPEP §706.07(a)). In practice, this prevents piecemeal prosecution of the application, which the MPEP instructs should be avoided. (MPEP §707.07(g)).*

Thus, it is submitted that the Office's failure constitutes a failure to expeditiously provide the information necessary to resolve issues related to patentability that prevents the Applicant from, for example, presenting appropriate patentability arguments and/or rebuttal evidence. (See The

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Official Gazette Notice of November 7, 2003).

**Neither the First Office Action on 10/16/2008, Nor the Second Office Action  
on 7/9/2009 Considered the Merits of Claims 349 - 382 or Claims 383 - 416.**

**Office Action / Subject Matter Considered by the USPTO:**

**Date:**

**07/9/09**

Section 102:

**“Composite support which has at least two ... materials or components that are  
combined together to make the support i.e., two constituent ingredient materials...”**  
(Exhibit I, page 1-2)

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Section 102:

**“Composite support which has at least two ... materials or components that are  
combined together to make the support i.e., two constituent ingredient materials...”**  
(Exhibit I, page 3a-c)

**04/30/08**

Section 102:

**“Composite support which has at least two ... materials or components that are  
combined together to make the support i.e., two constituent ingredient materials...”**

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(Exhibit I, page 4)

10/29/07 Section 102:

Edible **support** structure **made of stick...** as instantly claimed. (Exhibit I, page 5)

05/8/07 Section 102:

"Edible **support** structure **made of stick...** as instantly claimed.." (Exhibit I, page 6)

06/1/06 Section 102:

"Edible **support** having at least two ...members" (Exhibit I, page 7)

10/7/05 Section 102:

"Edible **support** having at least two ...members" (Exhibit I, page 8)

### Initial Burden

Examiner is required per 37 CFR 1.104(c)(2) entitled "Examiner's Action - Rejection of claims" to 1) point out with particularity where each and every element of a claim may be found in a cited reference; and 2) explain the pertinence of each cited reference as indicated hereafter:

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“In rejecting claims for want of novelty or for obviousness the examiner must cite the best reference at his or her command. ...**The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.** 937 CFR 1.104(c)(2)

**N.B.** In view of the foregoing, if an Office Action fails to provide the requisite **factual basis for an anticipation rejection**, it is submitted that the rejection is deficient as the Applicant is left to speculate as to the basis for the rejection. The BPAI considers such a deficiency reversible error:

“Here, the Examiner has merely directed our attention to an ‘EJB Type’ column in Beust and thus has not clearly shown and has left it up to us to speculate as to how this column in Beust defines resource references within a session EJB. We can only rule on the basis of the evidence that is provided in support of the rejection, and here we find it deficient. The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. § 102. In re Piasecki, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing In re Warner, 379 F.2d 1011, 1016 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the Examiner. In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Therefore, we find that the Examiner has not set forth a sufficient initial showing of anticipation, and we find that Appellants have shown

error in the Examiner's rejection of claims 2 and 10." (Ex parte Dykes et al. Appeal No. 2009-7556 (BPAI))

Furthermore, the Federal Circuit has indicated that sufficiently particular factual findings ("without resort to speculation") required for an anticipation rejection allow "an appellate court to fulfill its role of judicial review":

"For an appellate court to fulfill its role of judicial review, it must have a clear understanding of the grounds for the decision being reviewed ... necessary findings must be expressed with sufficient particularity to enable our court, without resort to speculation, to understand the reasoning of the Board, and to determine whether it applied the law correctly and whether the evidence supported the underlying and ultimate fact findings ... in sum, we hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review. In particular, we expect that the Board's anticipation analysis be conducted on a limitation by limitation basis, with specific fact findings for each contested limitation and satisfactory explanations for such findings." *Gechter v. Davidson*, 1167 F.3d 1454 (Fed. Cir. 1997)

Applicant was diligent and informed Examiner that the Office Actions did not touch the merits of Applicant's invention.

MPEP 706.07(c) Final Rejection, Premature; Any question as to prematurity of a final rejection should be raised, if at all, while the application is still pending before the primary examiner.

(See Response to non-final Office Action - Exhibit E, pages 1-3); (Response to final Office Action- Exhibit E, pages 4-5)

Examiner did not thereafter address the merits in the following Office Action or communication, but continued to disregard Applicant. (MPEP § 707.07(f))

**MPEP 707.07(f)** of the Manual of Patent Examining Procedure instructs that:

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

The Office repeated the rejections of all of the claims. The Office, however, neither "took note" of Applicant's argument nor "answered the substance" of it. (707.07(f) Examiner did not address the merits of: "a support for a frozen comestible comprising a "composite material," but only addresses: a "composite support" having two materials or components. (Final Office Action, Response to Arguments pg. 12, II a, pg. 13 II b, c, d) Thus, Applicant respectfully submits that the final Office Action is further deficient because the Office failed to satisfy the requirements of MPEP § 707.07(f). (Exhibit E, pages 4-5)

## **II - Restriction/Election**



**The Second Office Action Should Not Have Been Made Final  
as the Means and Method Claims were Removed from Examination  
Without any Explanation or Evidence of a Distinct Invention**

**Re: Decision on the Petition**

The decision on the petition of 11/16/2010 in response to Applicant March 29, 2010 stated:

Applicant's original species election (III) on January 23, 2003 was drawn to a composite support.

Claims 403 - 416 are directed to a method of making a support. The Office does not permit the

Applicant to shift to claiming another invention an election is made and an action given on the

selected subject matter.

In response, the decision on petition is based upon information intentionally taken out of context.

Applicant had given factual support of "composite material" from the specification, drawings, and

original claims *in every petition*. (Example: Original claims 6, 19, 21-23)

The Election/Restriction actually stated:

**Species III**, wherein the support is a composite support as shown e.g in Fig 1, or

**Fig. 1** teaches of "Support 62" a support for a frozen comestible comprising an "edible composite material." (Exhibit B, pg. 2, see "Species") (Exhibit A, pgs. 6 - 10). (See examples of: Milky Way(tm), Snickers (tm), Baby Ruth (tm), Kit Kat (tm), Twix(tm), Kudos (tm), Nestle Bites)

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Page 2 of the non-final Office Action states under Election/Restriction:

Newly submitted claims 370-372 are directed to a method of making a support i.e. An invention that is independent or distinct from the invention elected in response filed January 18, 2003 to the original restriction requirement.

Since applicant had elected a product and not the method of making in response to the election requirement the method of making the product, i.e., claims 370-382 are withdrawn from consideration a being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP section 821.03. Thus claims 345-348 will not be examined in the present Office Action.

In response, Examiner had not given any reason or factual evidence that claims 345-348 were drawn to a non-elected invention. (Exhibit B, pgs. 1 - 2) Election/Restriction of both Office Actions) Other than to just state:

“Since applicant had elected a product and not the method of making in response to the election requirement the method of making the product, i.e., claims 370-382 are withdrawn from consideration a being directed to a non-elected invention.

“it is submitted that the rejection is deficient as the Applicant is left to speculate as to the basis for the rejection” (as above) since the rejection does not provide any factual evidence of being directed to a non-elected invention. (MPEP 803 - Restriction when Proper (only if they are able to

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support separate patents and they are either independent (MPEP § 802.01, § 806.06, and § 808.01<) or distinct ( MPEP § 806.05 - § 806.05(j)<).)

**“The action should include form paragraph 8.04.”**

MPEP 821.04, ¶ 8.04 Election by Original Presentation

Newly submitted claim [1] directed to an invention that is independent or distinct from the invention originally claimed **for the following reasons:** [2]

Other than a standard MPEP boilerplate paragraph, above, no specific reason has been given.

(MPEP 803 - Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases.)

Examiner did not include form paragraph MPEP 8.04 or give any reason or examples to support Examiner's conclusions. Examiner has not made a prima facie case of distinct inventions.

Applicant elected a **species**. 35 USC Section 112(6) allows an applicant to claim their invention in terms of a **means claim**. It is up to the Patent and Trademark Office to make a case for distinct inventions. The Office has not made a prima facie case of a distinct or a non-elected invention.

The Office Action is deficient for the removal of means claims 370, 371 without reason. Thus, the

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finality of the Office Action is premature.

Applicant elected Examiner's Species **III** - wherein the support is a composite support, as shown e.g. in Fig. 1 (Exhibit F, page 4) Method claims 28 and 30 [29] were filed in the original disclosure (Exhibit F, page 5)

Applicant notified Examiner that no restriction regarding a method claim had been made. (Exhibit F, page 1) Examiner ignored Applicant and just repeated the rejection in the final Office Action.

Examiner has not addressed every issue under the policy of compact prosecution. MPEP 707.07(g) It is still the initial obligation of examiner to state specifically how claims 403 - 416 are directed to a distinct and non-elected invention, as Examiner maintains, before withdrawing these claims from examination. Thus, a response from Applicant did not necessitate the new grounds of rejection.

Section 707.07(f) of the Manual of Patent Examining Procedure (MPEP) instructs that:  
Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

Examiner did not answer. Examiner's response to Applicant's Arguments (Final Office Action, pgs. 11 - 14) are considered "double talk" to a person having ordinary skill in the art. These

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comments take Applicant's argument out of context. Examiner has not answered the "substance" of any of Applicant's arguments. Examiner has even admitted that the entire support of Musher is frozen. (Final OA, Response to Arguments, Pg. 13 II d "and the entire structure is frozen.")

**35 USC section 112(6) states:**

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

**35 USC section 112(6)** provides that an applicant is entitled to a "means" claim. Examiner has provided no evidence or explanation of a distinct invention of claims 368 - 369 [403 - 404] vs. that of examined claims 349 - 369 [383 - 402]. Without this evidence the finality of the Office Action is premature. Examiner must not remove the claims from examination without a valid reason as to a distinct invention worthy of a separate patent. Examiner must provide reasons (MPEP 803) Examiner's removal of claims 349 - 369 [383 - 402] is unjustified.

**35 U.S.C. 101** Inventions patentable.

Whoever invents or discovers any new and useful **process**, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Examiner has provided no evidence or explanation of a distinct invention of claims 403 - 416 vs. that of examined claims 383 - 402. Without this evidence Applicant is entitled to claim Applicant's invention in terms of a method(s) claim. 35 USC Section 102 and ( ¶ 8.04 Election by Original Presentation Newly submitted claim [1] directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: [2])

A boilerplate statement that Applicant elected a product instead of a method, which is not particular to Applicant's claims, is not a valid reason. Applicant elected a species and is entitled to claim the invention in terms of a method. 35 U.S.C. Section 101

For these reasons, Applicant respectfully submits that the Office Action of 7/9/09 was clearly deficient. The initial burden of stating how claims 370 - 382 / 403 - 416 are a distinct invention from claims 383 - 402 remains with the Office at this time. The burden did not shift to Applicant. Therefore, for these reasons, Applicant's amendment did not necessitate the new grounds of rejection presented in the Office Action.

### III.

#### Amendments to Specification

#### The Final Office Action Was Premature As Examiner Neither Took Note of Applicant's Argument Nor Answered the Substance of It

On the rejection of "new matter," Applicant respectfully submits that the finality of the Office

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Action was premature, as Examiner did not give any valid reasoning or evidence that the term "composite material" in the specification is "new matter." It is the initial burden of Examiner to provide a prima facie case of "new matter." (MPEP 707.07(g); 35 USC section 102.

Applicant also respectfully submits that the second Office Action was premature as Examiner neither took note of Applicant's argument, nor answered the substance of it. (MPEP 707.07(f))

The Final Office Action pgs. 2-3 stated :

The amendment filed March 16, 2009, is once again objected to under 35 USC 132(a) because it introduces new matter into the disclosure. 35 USC 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material not supported by the original disclosure is as follows: the addition of "composite material" in paragraphs [0043][0044][0164] ad [0166], **which was not disclosed in the specification as originally filed** and has also been added to claims. The term "a composite material" as disclosed in the amendment would introduce new matter and change the description from "a candy bar" to a "composite material candy bar" in paragraph [0164], which is not the same as a generic term "candy bar" as originally described. Therefore, the amendments to the specification introduce new matter and the applicant is required to cancel the new matter in the reply to this Office Action.

Applicant stated in the response to the non-final Office Action 10/16/08 that under **MPEP 608.01**

- Original Claims: in establishing a disclosure, applicant can rely not only on the

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description and drawing as filed but also on the original claims if their content justifies it. (Exhibit H, pages 1-3) Applicant also gave a myriad of factual evidence that "composite material" was not "new matter." Applicant notified Examiner many times that original claim 6, 19, 21 - 23 recited a "composite material." Applicant notified Examiner about the specification which recites many examples of composite candy bars, such as Snickers, Milky Way, Baby Ruth, Twix and Kudos. (Exhibit H, pg. 2 - 3) Applicant notified Examiner where the specification recites "composite candy bar." (Exhibit A, pgs. 6 - 8)

Examiner, however, did not take note of the Applicant's argument and answer the substance of it, but ignored Applicant. (MPEP 707.07(f)) (See **Response to Arguments**, Final Office Action 7/9/09 11-14) Please notice that there is no mention that "composite material" does/does not comprise "new matter" in the response to Applicant's Arguments or anywhere in the final Office Action (pgs. 11 - 14). Examiner just repeated the rejection and made the second office final.

Examiner is aware of Applicant's patentable subject matter. (First Office Action 5/23/2003) - (Exhibit A, pgs. 1 - 4), (original claims (exhibit A, pgs. 1-3) and a Requirement for Restriction requested "which kind/flavor 'composite material.'") (Exhibit B, pg. 1)

The PTO is trying to renege on its determination of the MERITS of the claims.

Applicant continually directed Examiner to examples of support for a "composite material" in specification, claims and drawings, (Exhibit A, pgs. 11 - 13). Applicant was ignored. The



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objection was repeated and the second Office Action was made final. The Office required Applicant to cancel Applicant's patentable subject matter as a requirement for examination. The Office is aware of Applicant's patentable subject matter. The fact that the Office intentionally required Applicant to cancel Applicant's subject matter is a deliberate act to deny Applicant a right to a patent to at least under 35 USC Section 102. This is prejudice against Applicant.

All cited art had been overcome by Applicant in the response to the Office Action of 3/9/2004, directed to "composite material." (This page is also listed as Exhibit B, pages 9, 10, in Appeal of April 12, 2011 for 11/903,722)

**All Cited art had been withdrawn.**

**N. B.** If the claims *were* directed to a mere "composite support," as Examiner contends, the cited art to Reference N (Swiss 649197) under section 102, and Reference N in view of the teachings of (Swiss 649197), Barricini (US 2,469,589), Gaul (Germ 3617093), Firmin (US 1769,215), Jones (US 1,947,010), Ref. Q (Swiss 647394), Suskind (US 2,832,708), Parr (US 1,835,719), Kennedy (US2,464,515), Hart et al. (US 6,054,158)... under section 103 (Exhibit B, pg. 3a-c) would NOT have been withdrawn. [emphasis added] but they were withdrawn. (Exhibit B, pgs. 4a-b) Notice only the reapplied reference to Musher is cited and newly cited references to Berg and Hammond have been put in (Exhibit B, page. 4c).

These cited art references were withdrawn even though they comprised a "composite support"

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which has at least two ... materials or components.”

This means that these references were withdrawn because they did NOT comprise a “composite material.” [emphasis added]

The Patent and Trademark Office withdrew these references of its own accord since they did not comprise a “composite material.”

This means that not only did the Patent and Trademark Office understand the merits of the claims at the time of the very first Office Action, but the Patent and Trademark Office acted upon these merits. MPEP 818.02(a)

The record shows that the Office Actions that have rejected the claims of the above application on the merits of:

“‘composite support’ comprising two materials or components that are combined together to make the support,”

are improper Office Actions. Thus, at least the Office Actions in the table below have been sent as intentional delay.

### **Examiner Unjustly Required Applicant to Cancel Applicant's**

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### **Patentable Subject Matter As a Requirement for Examination**

N.B. Examiner, being fully aware of Applicant's patentable subject matter and, as the record shows, required Applicant to "cancel" this patentable subject matter, i.e. "composite material," as a requirement for examination. Applicant advised Examiner for many years where support for the term "composite material" could be found in the original specification, claims, and drawings.

MPEP 2111.

Applicant respectfully submits that the Office Actions of at least 10/16/08 and 7/9/09 requiring Applicant to "cancel" applicant's subject matter (35 USC section 102), and whose support for the term is entirely and consistently ignored, (MPEP 707.07(f)) are totally improper and thus the finality of the Office Action was premature.

The record shows that the Patent and Trademark Office readily took and continues to unlawfully take monies time and time again out of Applicant's account and deposit it into its own account, knowing fully well the merits of Applicant's invention, with the intent of not examining the above application on valid grounds, as shown in the record for many years. Applicant respectfully submits that this is a serious misuse of the authority of an examiner, the Patent and Trademark Office and the law. Applicant submits that this is willful and intentional prejudice toward Applicant and a denial of a patent under 35 USC Section 102. Applicant's fee entitles an applicant to a full and complete examination on the true merits of the claims.

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Applicant respectfully submits that this intentional activity has been going on for years and considers this activity the unjustified taking of Applicant's fees. Applicant had paid for, and is thus entitled to a full and complete action on the true merits, as first examined by the Office.

Knowing that the Office acted upon "a composite" comprising "elements a through m" in the first Office Action, (MPEP 818.02(a) and withdrew all cited references based upon "a composite," and then afterwards turning 180 and rejecting the claims based upon "composite *support* having two materials" for years, i.e. shows intent, a person having ordinary skill in the art may well consider this stealing.

Applicant's amendment did NOT necessitate the new ground of rejection presented in the final Office Action. Examiner did not present a prima facie case of anticipation on the merits first acted upon by the Patent and Trademark Office in either the Office Action of 10/16/08 or the Office Action of 7/9/2009. Thus, it is still the obligation of the Office to do so. MPEP, 707.07(g) Thus the Office Action was premature.

**Additionally, The Second Office Action Should Not Have Been Made Final  
as It Introduced a New Ground of Rejection That Was Neither  
Necessitated by Applicant's Amendment of the Claim,  
Nor Based on Information Submitted in an Information Disclosure Statement**

**706.07(a) Final Rejection, *When Proper* on Second Action [R-6] (as above)**

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Under present practice, second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement* filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

The pertinent portion of 707.07(a) then states:

“...except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement...”

A new reference to **Lane et al.** (US 1,690,984) was introduced in the final Office Action which was not necessitated by Applicant's amendment of the claims, nor based on information submitted in an Information Disclosure Statement. (MPEP 707.07(a)) (Exhibit G, pages 1-2)

The Final Office Action stated:

(A) Claim 391 is rejected under 35 USC 103(a) as being unpatentable over Feybusch in view of Lane et al (US 1690984), hereinafter Lane.

As above, the Final Office Action of 7/9/2009 stated:

Applicant's amendment necessitated the *new ground(s) of rejection presented in*

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*this Office Action.* Accordingly, THIS Office Action IS MADE FINAL. See MPEP section 706.07(a).

Applicant disagrees with Examiner's decision.

Examiner has thus admitted that new ground(s) of rejection were presented in the Final Office Action. This new ground of rejection, however, was not necessitated by an IDS, nor an amendment of Applicant, as maintained by Examiner.

**3/16/2009** - Claim 391 recited:

The support for a frozen comestible of claim 383 wherein one of said two constituent materials comprise an edible hollow confection length, wherein the other of said two constituent materials comprises an edible filling placed in said hollow length, wherein said filling comprises a plurality of candy beads, colored sugar, flavored sugar, an edible confection rope, or a fluid ingredient, said two ingredient materials comprise two ingredient materials placed concentrically.

**6/30/2008** - Claim 350 recited:

The support for a frozen comestible of claim 383 wherein one of said two constituent materials comprise an edible hollow confection length, wherein the other of said two constituent materials comprises an edible filling placed in said hollow length, wherein said filling comprises a plurality of candy beads, colored

sugar, flavored sugar, an edible confection rope, or a fluid ingredient, said two ingredient materials comprise two ingredient materials placed concentrically.

Claim 391 (hollow confection length) (Exhibit G, page 3; March 16, 2009) was available for examination on July 30, 2008, in its entirety, prior to a first Office Action following an RCE. (Exhibit G, page 4)

Examiner should have examined this claim on this first Office Action of 10/16/2008 in compliance with the Policy of Compact Prosecution, MPEP 707.07(g), as obligated, (burden of Examiner) but did not. Examiner waited until the final Office Action of 7/9/2009 to introduce the new reference to Lane et al..

Since this claim (hollow confection length) should have been examined at the time of the first Office Action following an RCE on 10/16/2008 (**Policy of Compact Prosecution MPEP 707.07(g)**), and Examiner did not, Examiner did introduce a new ground of rejection (Lane et al.) that was neither necessitated by amendment of the claims, nor based on information submitted in an information disclosure statement." (MPEP 706.07(a), above (MPEP 707.07(a) When Proper on Final) (Exhibit G, page 5, Lane et al.)

Thus, the second Office Action was in fact premature and should not have been made final.

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For this additional reason, Applicant respectfully submits that Applicant's amendment did NOT necessitate the new grounds of rejection presented in the Office Action under MPEP section 706.07(a) and respectfully requests that the finality of the second Office Action be withdrawn as it was premature.

### 35 USC Section 102

#### The Final Office Action Was Premature As Examiner Did Not

#### Point Out with Particularity which Limitation of Which Claim

#### May be Found in the Cited Art Reference.

With regard to the non-final Office Action and Musher, claims 349 -369 had been generally rejected. However, the Office Action failed to state which claim in particular was being rejected in the Detailed Action. The Examiner had not specified which claim by number, to which the Examiner was referencing. "Each claim" had not been rejected on valid grounds, as required. MPEP 707.07(g). It is unclear as to which claim the Examiner is rejecting and for what reason. (Non-final Office Action, pages 10-12) Examiner is required per 37 CFR 1.104(c)(2) entitled "Examiner's Action - Rejection of claims" to 1) **point out with particularity where each and every element of a claim may be found in a cited reference**; and 2) explain the pertinence of each cited reference as indicated hereafter:

The Office has the initial burden of producing factual evidence that Applicant's claims have been



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anticipated by the reference to Musher. The Office Action states that Applicant's independent claims 349 - 369 have been anticipated by Musher. The Office Action states that these claims have been anticipated on the basis that Musher teaches "a composite support."

Applicant was diligent and informed Examiner that the Office Actions did not touch the merits of Applicant's invention. Examiner did not change the Office Actions but again disregarded Applicant. (Response to non-final Office Action, Response to final Office Action, Exhibit E, pages 1-5)

A person having ordinary skill in the art is knowledgeable that a "composite support" made by attaching parts or components together, as Examiner maintains, does not consider or anticipate the merits of "a material that comprises two constituent materials," or a "composite material." A person having ordinary skill in the art is knowledgeable that in relying upon "composite support," that "composite material" had not even been considered in the Office Action. [emphasis added]

An edible "composite material" is well known. Applicant is not required to teach how to make and/or use a "composite material."

**N.B.** MPEP 2182 Scope of the Search and Identification of the Prior Art [R-2]

[A patent specification **need not teach, and preferably omits**, what is well known in the art. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).]

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Examiner is also aware of the subject matter of Applicant's disclosure of a support for a frozen comestible comprising an edible composite material and has for many years since 2000. (See Requirement for Restriction, below) Examiner, however, has chosen to ignore Applicant's known patentable subject matter. MPEP 818.02 (acted upon by the Office in the first Office Action) This is respectfully submitted to be knowledgeable and willful delay on the part of the Patent and Trademark Office.

According to Section 102, and 37 CFR 1.104(c)(2), it is the obligation of the examiner to produce factual evidence that Musher has anticipated Applicant's invention. Examiner has produced no evidence of prima facie anticipation that Musher had invented a support for a frozen comestible comprising a material that comprises two constituent materials or an edible composite material. Examiner has not even considered any pending claims.

### **Policy of Compact Prosecution**

The Manual of Patenting Procedure section 707.07(g) Piecemeal Examination states:

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See MPEP § 904.03.)

### **The Office's Obligations**

A first Office Action on the merits should ordinarily identify every issue that stands between the